BY FACSIMILE ONLY

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513

September 12, 2002

Opposition No. 91150094

Old World Industries, Inc. *and*
Splitfire International, Inc.
v.
Auto Meter Products, Inc.

David Mermelstein, Attorney:

This case now comes up on opposers' motion to compel discovery, filed August 19, 2002, and applicant's request for a telephone conference on the motion. The Board, having determined that the issue is appropriate for resolution by a telephone conference, conducted such a hearing on September 6, 2002. Participating were Phillip T. Petti and Sandra V. Scavo, for applicant, Sanjiv D. Sarwate, for opposers, and the above-signed Board attorney.

Facts

The facts relevant to the current motion are not subject to significant dispute. The notice of opposition was filed on July 2, 2001, alleging that applicant's mark[1]

[1] Application Serial No. 75/457,081, filed March 25, 1998, for "automotive measuring instruments; namely, oil pressure, water temperature, vacuum, ammeter, volt meter, fuel pressure, fuel level and oil temperature gauges, hourmeters, speedometers and tachometers for the automotive aftermarket." The mark is for the

has not acquired secondary meaning and is functional. As reset by applicant's consent motion, approved by the Board on May 4, 2002, discovery closed on June 7, 2002, although the parties apparently agreed to conduct several depositions beyond the close of discovery, including the one at issue here.

Opposers took the deposition of John Bunge on June 28, 2002. Mr. Bunge had been retained by applicant to conduct a survey on secondary meaning and to testify thereon. During the course of the deposition the following exchange took place:

> [Mr. Sarwate] Q. Okay. Have you done any other surveys on behalf of Auto Meter other than the one reflected in Exhibit 35?
>
> Ms. Scavo: Objection, work product.
>
> Mr. Sarwate: We are entitled to know everything he has done – he is doing for Auto Meter in this matter, and I don't think that objection is well taken at all. We will move to strike the report if he does not provide an answer.
>
> Ms. Scavo: Mr. Bunge is being offered for a – his secondary meaning survey that the has completed and that we have produced, and to the extent that this testimony calls for subject matter that goes beyond, that is not being offered here.
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> Mr. Sarwate: These are all issues relating to his credibility and to the relationship between

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configuration of a part of the goods "consist[ing] of the bezel shape which consists of a raised bezel with a convex outer periphery and a convex inner periphery." Applicant alleges a first use anywhere and in commerce of "at least as early as 1968."

> Mr. Bunge and Auto Meter, and we are entitled to know that information.
>
> Mr. Newbury: Just move to strike it at the right time.
>
> Mr. Sarwate: Are you still instructing the witness not to answer?
>
> Ms. Scavo: Yes.
>
> Mr. Sarwate: We will deal with that at the appropriate time then.
>
> By Mr. Sarwate:
>
> Q: Have you done any other surveys relating to Old World or Splitfire?
>
> Ms. Scavo: I will renew my same objection, that he is being offered for testimony relating to a secondary meaning survey and report that he has prepared.
>
> Mr. Sarwate: Okay. So noted, and we will deal with that at the appropriate time.

Following Mr. Bunge's deposition, on August 9, 2002, opposers filed a consent motion for a fourteen-day extension of trial dates, which was approved by the Board on August 21, 2002. Pursuant to the new schedule, opposers' testimony period would open on August 20, 2002. Opposers stated that the "extension [was] requested to allow parties [sic] to discuss settlement possibilities." As indicated above, the instant motion was filed on August 19, 2002, one day prior to the opening of opposers' rescheduled testimony period.

Proceedings Suspended

During the telephone conference, the Board informed the parties that they should consider the proceeding suspended prior to the opening of opposers' testimony period.

Discoverability of Expert Opinions and Related Matters

Opposers seek an order compelling applicant's expert to answer questions regarding (1) other work the expert has performed for applicant (whether or not related to this proceeding) and (2) work the expert has performed for third parties which relates to opposers. Opposers also seek production of "all documents relating to matters on which Mr. Bunge was improperly instructed not to testify…."[2] In support of its motion, opposers cite two non-TTAB cases which seem to support opposers' position that some such information may be discoverable for purposes of impeachment.

In response to the motion to compel, applicant contends that Board precedent does not permit extensive discovery of expert witnesses, requiring only disclosure of the name of the expert witnesses which a party intends to present at trial. Since the expert witness need not answer any questions, it need not answer the ones at issue here.

[2] Opposers' demand for documents is untimely. Discovery is closed, and indeed was closed at the time of Mr. Bunge's deposition. The parties indicated that they agreed to take depositions – including that of Mr. Bunge – beyond the close of discovery. However, there does not appear to have been an agreement to allow the use of other discovery means, such as requests for the production of documents.

Applicant is correct, up to a point. As noted in TBMP § 419(7),

> A party need not, in advance of trial, specify in detail the evidence it intends to present, or identify the witnesses it intends to call, except that the names of expert witnesses intended to be called are discoverable. *See British Seagull Ltd. v. Brunswick Corp.*, 28 USPQ2d 1197 (TTAB 1993), *aff'd, Brunswick Corp. v. British Seagull Ltd.*, 35 F.3d 1527, 32 USPQ2d 1120 (Fed. Cir. 1994); *Charrette Corp. v. Bowater Communication Papers Inc.*, 13 USPQ2d 2040 (TTAB 1989); *Polaroid Corp. v. Opto Specs, Ltd.*, 181 USPQ 542 (TTAB 1974); and *American Optical Corp. v. Exomet, Inc.*, 181 USPQ 120 (TTAB 1974).

The trouble with applicant's argument, however, is that rather than serving a general objection to the notice of Mr. Bunge's deposition or moving to quash it, applicant produced the witness and allowed him to answer questions. If a deposition witness is generally immune from questioning, the party producing the witness may not selectively choose the questions to which the general objection will be made. Applicant produced its expert witness for questioning without objection, and allowed him to answer other questions. Applicant may not justify withholding certain information on the ground that the witness did not have to appear at all. Accordingly, we view this objection to the questions as waived.

Timeliness

Applicant also argues that opposers' motion is untimely because opposers' most recent request for resetting of the testimony periods was made for the purposes of settlement

discussions, not for filing motions. According to applicant's argument, the time for filing applicant's motion to compel had already expired, presumably because the extension of time was not for any purpose other than settlement.

Again, we disagree with applicant's reasoning. Although opposers' consent motion does state that it was made for the purposes of settlement, we do not construe it as limited *only* to settlement. Unless a motion (or order of the Board) clearly and unambiguously states that no motions may be filed during an extended period, the Board will presume that any motion may be filed as may be otherwise appropriate. If the parties desired an extension of testimony dates for the purpose of negotiation only, the proper procedure would have been to request suspension of the case, which would have prohibited the filing of motions during the suspension period. The Board will not bar the parties from filing motions during a consented-to extended period unless the parties' intent to do so appears clearly and unambiguously in the motion.

Nevertheless, we conclude that applicant is correct in that opposers' motion is untimely. Pursuant to the Board's rules, a motion to compel discovery must be filed prior to the opening of the first testimony period as originally set or reset. Trademark Rule 2.120(e)(1). Under applicant's

consent motion of March 25, 2002, opposers' thirty-day testimony period was set to close on September 5, 2002, *i.e.*, opening on August 6, 2002. Opposers' August 9, 2002, consent motion was filed under certificate of mailing dated August 6, 2002, the day its testimony period opened. Although testimony was reset by the consent motion, it had already opened on August 6, thus making any subsequent motion to compel untimely. *Cf.* TBMP § 528.02 ("Once the first trial period commences, however, any summary judgment motion filed thereafter is untimely, *even if it is filed prior to the opening of a rescheduled testimony period-in-chief* for plaintiff, and/or even if no trial evidence has actually been adduced by the plaintiff.")(emphasis added).[3] Accordingly, opposers' motion to compel is DENIED,[4] except to the extent set out below.

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[3] When the Trademark Rules were amended effective October 1998, the new timeliness requirement for motions to compel discovery pursuant to Trademark Rule 2.120(e)(1) used the same language as that applied to motions for summary judgment under Trademark Rule 2.127(e). Although no citable orders have issued on this point, the Board's practice has been to apply the new rule consistent with previous practice in connection with motions for summary judgment.

[4] Even if we were to reach the merits of opposers' motion, it is unlikely that we would grant opposers more than what applicant has already volunteered. Particularly, even if it is accepted that the amount the expert has earned from the applicant *might* form a foundation for a claim of bias, there is no reasonable basis for the discovery of the expert opinions, surveys and other documents in matters not related to this proceeding.

Moreover, the relevance of any information regarding work the expert has performed which involves opposers (but not applicant) is even more tenuous. Many such matters may involve confidences of third parties and are substantively unrelated to this matter.

Information Volunteered

During the course of the telephone conference on the current motion, applicant volunteered to provide opposers with the dollar amount that Mr. Bunge has earned as a result of services rendered to applicant. Accordingly, applicant is allowed THIRTY DAYS in which to provide such information to opposers with the same formality as a response to an interrogatory.

Dates Reset

Proceedings are RESUMED. Because it does not appear that follow-up discovery would be appropriate, *see supra* note 4, discovery is CLOSED except as set out herein. Trial dates are reset as follows:

Further, information about work the expert has performed for other parties which involved opposers is highly unlikely to lead to admissible evidence in this proceeding. *See* Fed. R. Civ. P. 26(b)(1)("Parties may obtain discovery regarding any matter … that is relevant to the *claim or defense* of any party….").

Indeed, the only reason this latter category of evidence would be relevant is if Mr. Bunge were biased not merely in favor of his client, the applicant herein, but *against* the opposers. However, there does not appear to be any basis to even suggest such a bias in this case, and it is not appropriate to allow such intrusion into the expert's personal or professional life on the unlikely possibility that something may be found with which to impeach the witness. Needless to say, Mr. Bunge is not on trial in this case. In the absence of substantial evidence of bias, opposers would do well to concentrate on the substance of the expert's testimony.

DISCOVERY PERIOD TO CLOSE:	**CLOSED**
Thirty day testimony period for party in position of plaintiff to close:	**November 20, 2002**
Thirty day testimony period for party in position of defendant to close:	**January 19, 2003**
Fifteen day rebuttal testimony period to close:	**March 5, 2003**

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.l25.

Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.l29.

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